

Appl. No.: 09/942,872
Amdt. dated 05/20/2005
Reply to Official Action of April 1, 2005

REMARKS/ARGUMENTS

This correspondence is filed in response to the final Official Action dated April 1, 2005 for this request for continued examination (RCE). The final Official Action continues to reject Claims 1-21 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,991,528 to Taylor et al. In addition, the final Official Action continues to reject Claims 1-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More particularly, the Official Action rejects independent Claims 1, 8 and 15, and by dependency Claims 2-7, 8-14 and 16-21, as including a term the Official Action alleges is unclear. In contrast to the previous rejection under § 112, second paragraph, however, the final Official Action now alleges a different term is unclear.

As explained below, Applicant respectfully submits that the Examiner prematurely issued a final Official Action due to the introduction of the new ground of rejection of Claims 1-21 under § 112, second paragraph. As also explained below, Applicant again respectfully submits that the claimed invention of Claims 1-21 is patentably distinct from the Taylor patent, and therefore, again traverses the rejection of such claims as being anticipated by the Taylor patent. In light of the remarks presented herein, Applicant respectfully requests withdrawal of the finality of the April 1, 2005 Official Action, as well as reconsideration and allowance of all of the pending claims of the present application.

I. FINALITY OF THE OFFICIAL ACTION IS PREMATURE

In the first Official Action dated July 19, 2004, the Examiner rejected Claims 1-21 under § 112, second paragraph, alleging that, in Claims 1, 8 and 15, a first phrase "when the at least one motion device is configured to operate on at least one object, information regarding the at least one object," was grammatically unclear. In addition, the first Official Action alleged that a second phrase, "the electronic simulation information is otherwise capable of being used to verify the operation of the at least one motion device produced by a set of operation information," was unclear as to what is "produced" by the set of operation information, as well as in what capacity the electronic simulation is used to enable this simulation. In response,

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Applicant amended independent Claims 1, 8 and 15 to further clarify the first phrase in a manner consistent with the Examiner's interpretation of that phrase.

Applicant traversed the § 112, second paragraph rejection as to the second phrase, explaining that the second phrase is clear. More particularly addressing the Examiner's allegation with respect to the term "produced," Applicant explained that, as recited by independent Claims 1, 8 and 15, operation is produced by the set of operation information, where the produced operation is that of the motion device(s).

Now, in the final Official Action, the Examiner again rejects Claims 1-21 under § 112, second paragraph. In contrast to the first Official Action, however, the Examiner now alleges that the second phrase is unclear as to the term "otherwise." More particularly, the Examiner now alleges that independent Claims 1, 8 and 15 are unclear as to "when precisely the step of verifying operation of the at least one motion device would be performed." Official Action of April 1, 2005, page 2. Continuing, the Examiner alleges that "it is not clear in what capacity the electronic simulation is used to enable this simulation." *Id.*

In accordance with MPEP § 706.07(a), a second or subsequent Official Action shall be made final, "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p)." In the instant case, by newly alleging that independent Claims 1, 8 and 15 are unclear as to the recited term "otherwise" in the context of the claim, the Examiner has introduced a new ground of rejection. In this regard, the second phrase in, including the term "otherwise" is in the same form is independent Claims 1, 8 and 15 as it appeared when the Examiner issued the first Official Action of July 19, 2004. At this point, the Examiner could have objected to the term "otherwise," and alleged that it was unclear in the context of independent Claims 1, 8 and 15. Instead, the Examiner only objected to the term "produced," as it appeared in the second phrase. Now, in the Official Action of April 1, 2005, the Examiner no longer objects to the term "produced," but alleges that the term "otherwise" is unclear within the second phrase. Accordingly, in the Official Action of April 1, 2005, Applicant

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respectfully submits that the Examiner introduced a new ground of rejection of Claims 1-21 under § 112, second paragraph.

In response to the first Official Action, Applicant did not amend independent Claims 1, 8 and 15 with respect to the second phrase. In fact, Applicant traversed the § 112, second paragraph rejection of Claims 1-21 as being unclear with respect to the second phrase. Thus, Applicant respectfully submits that the Examiner did not introduce the new ground of rejection for any reason necessitated by Applicant's amendment of independent Claims 1, 8 and 15 with respect to the second phrase. Further, Applicant has not filed an information disclosure statement since before mailing of the first Official Action of this RCE on July 19, 2004. Thus, Applicant also respectfully submits that the Examiner did not introduce the new ground of rejection for any reason necessitated by Applicants filing of an information disclosure statement during the period following mailing the mailing of such as first Official Action, as would be during the period set forth in 37 CFR § 1.97(c).

Applicant therefore respectfully submits that in the Official Action of April 1, 2005, the Examiner introduced a new ground of rejection that was neither necessitated by Applicant's amendment of independent Claims 1, 8 and 15 nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c). Applicant also respectfully submits that, in accordance with MPEP § 706.07(a), the Examiner prematurely issued a final Official Action. Accordingly, Applicant respectfully requests withdrawal of the finality of the April 1, 2005 Official Action.

II. THE CLAIMS OF THE PRESENT APPLICATION ARE PATENTABLE

As indicated above, the Official Action continues to reject Claims 1-21 under 35 U.S.C. § 112, second paragraph; and also rejects Claims 1-21 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,991,528 to Taylor et al. Each rejection will now be separately addressed.

A. Claims 1-21 Are Definite Under 35 U.S.C. § 112, Second Paragraph

As indicated above, in rejecting Claims 1-21, the Official Action alleges that, in Claims 1, 8 and 15, the phrase "the electronic simulation information is otherwise capable of being used

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to verify the operation of the at least one motion device produced by a set of operation information," is unclear as to the term "otherwise." More particularly, the Official Action alleges that independent Claims 1, 8 and 15 are unclear as to "when precisely the step of verifying operation of the at least one motion device would be performed." Official Action of April 1, 2005, page 2. Continuing, the Examiner alleges that "it is not clear in what capacity the electronic simulation is used to enable this simulation." *Id.*

In contrast to the allegation of the Official Action, Applicant respectfully submits that the phrase, "the electronic simulation information is otherwise capable of being used to verify the operation of the at least one motion device produced by a set of operation information," is clear as to the term "otherwise." As explained in the specification of the present application, and in response to the first Official Action, a simulation element (e.g., operating the VERICUT software package) includes or receives electronic simulation information. In this regard, the electronic simulation information is representative of information regarding motion device(s), and is further representative of information regarding object(s) upon which the motion device(s) operate when the motion device(s) are configured to operate on object(s), as recited by independent Claims 1, 8 and 15. Conventionally, the setup component utilizes the electronic simulation information to allow a user to verify operation of motion devices, the operation being that produced by a finished set of operation information (e.g., machine control data (MCD) derived from a NC program produced from a CAM system). Pat. App. page 10, lines 6-10. That is, as recited by independent Claims 1, 8 and 15, the electronic simulation information is otherwise capable of being used to verify operation of the motion device(s) produced by a set of operation information.

The Official Action alleges that independent Claims 1, 8 and 15 are unclear as to when the step of verifying operation of the motion device(s) would be performed. As clearly recited by independent Claims 1, 8 and 15, however, verifying operation of the motion device(s) is not a step recited as being necessarily performed at any point in the method of independent Claim 1, or by the setup component of independent Claim 8 or the computer program product of independent Claim 15. Instead, as clearly recited by those claims, the recited use of the electronic simulation information to verify operation of the motion device(s) is an attribute (i.e., capability) of the

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simulation information. That is, the electronic simulation information recited by independent Claims 1, 8 and 15 may be used, but is not recited in independent Claims 1, 8 and 15 as being used, to verify operation of the motion device(s). More particularly, independent Claims 1, 8 and 15 are recited such that under any conditions other than extracting process information therefrom for use in the recited method or by the recited system or computer program product, the electronic simulation information is capable of being used to verify operation of the motion device(s).

Applicant therefore respectfully submits that independent Claims 1, 8 and 15, and by dependency Claims 2-7, 8-14 and 16-21, are clear, definite and do particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Thus, Applicant respectfully submits that the rejection of Claims 1-21 under 35 U.S.C. § 112, second paragraph, is overcome.

B. Claims 1-21 Are Patentable over the Taylor Patent

As explained in response to the first Official Action, although the Taylor patent and the claimed invention are both directed to manufacturing systems, the claimed invention is patentably distinct from the system disclosed by the Taylor patent. More particularly, in contrast to the claimed invention of amended independent Claims 1, 8 and 15, the Taylor patent does not teach or suggest extracting process information from electronic simulation, the process information thereafter being formatted, interpreted and distributed as operation information to control motion device(s).

In response to Applicant's assertions with respect to the Taylor patent, the Official Action alleges that the claimed invention is drafted so broadly that multiple interpretations of the Taylor system read on the claims. In a first interpretation, the Official Action urges that the multipurpose manufacturing geometry definitions file (MGDF) disclosed by the Taylor patent corresponds to the recited electronic simulation information. And in a second interpretation, the Official Action alleges that the disclosed spreadsheet program, spreadsheet data files, drawing database, engineering design program and MDGF generation program may be interpreted as including the recited electronic simulation information. Applicant respectfully submits,

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however, that under a proper interpretation of the Taylor patent, neither the disclosed MGDF nor the spreadsheet program/spreadsheet data files/drawing database/engineering design program/MDGF generation program combination are capable of being used to verify operation of motion device(s), recited by independent Claims 1, 8 and 15 as an attribute (i.e., capability) of the recited electronic simulation information.

As explicitly disclosed by the Taylor patent and shown in FIG. 2 (reproduced below), an expert system generates, from a MGDF 80, a manufacturing plan in the form of a process data file 104. Motion/process data generation programs 110 convert neutral source code in the process data file to code, such as NC/CNC motion data, executable by device controllers, where the conversion creates code for each device controller. In addition, the motion/process data generation programs may convert the neutral source code into motion data files 114 for each device controller, where the motion data files are thereafter passed to a motion/process verification program 120. The motion/process verification program then uses the motion data files to verify operation of the device controllers produced by the code generated by the motion/process data generation programs for execution by the respective device controllers. Taylor Patent, col. 8, ll. 17-55.

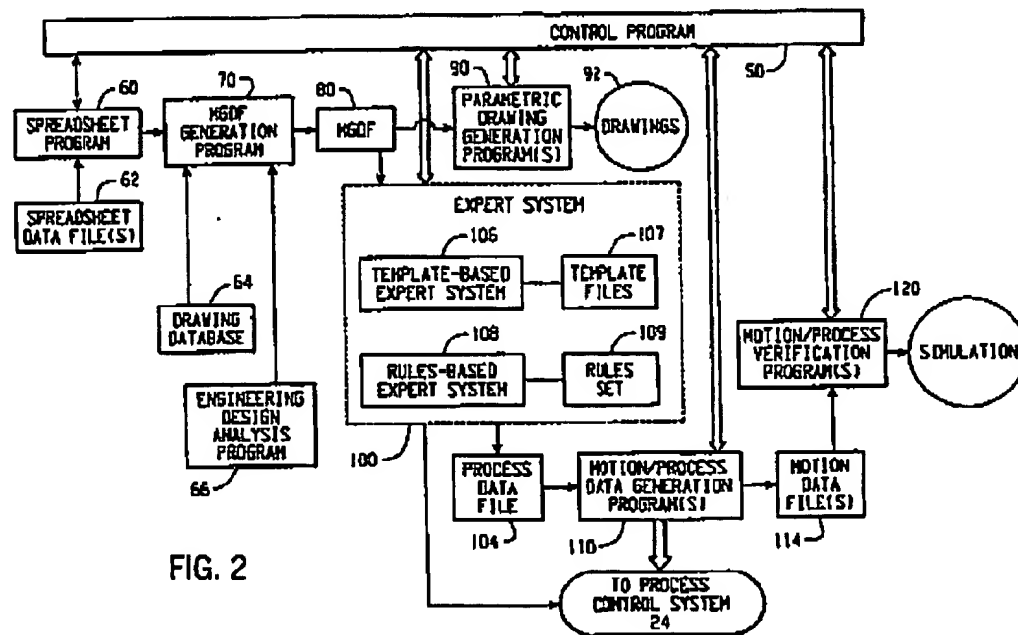


FIG. 2

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Therefore, under a proper interpretation of the Taylor patent, the motion data files 114 are the only elements that could even arguably correspond to the recited electronic simulation information. In this regard, the motion data files are the only pieces of information that are capable of being used to verify operation of motion devices, as is the electronic simulation information of independent Claims 1, 8 and 15. Thus, to even arguably disclose the claimed invention of independent Claims 1, 8 and 15, the Taylor patent must disclose that process information is extracted from the motion data files and formatted into neutral process information. However, other than verifying operation of the device controllers, the Taylor patent does not teach or suggest any operations are performed with respect to the motion data files, much less that anything is extracted from the simulation, much less process information, as is recited by the claimed invention. And as the Taylor patent does not teach or suggest extracting process information from the motion data files, the Taylor patent likewise cannot be interpreted to teach or suggest formatting the extracted process information into neutral process information, interpreting the neutral process information into operation information, and distributing the operation information to control motion device(s), as also recited by amended independent Claims 1, 8 and 15.

Applicant therefore respectfully submits that the claimed invention of independent Claims 1, 8 and 15, and by dependency Claims 2-7, 8-14 and 16-21, is patentably distinct from the Taylor patent. And as such, Applicant further respectfully submits that the rejection of Claims 1-21, under 35 U.S.C. 102(b) as being anticipated by the Taylor patent, is overcome.

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CONCLUSION

In view of the remarks presented above, Applicant submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

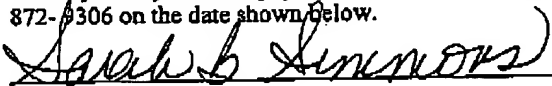


Andrew T. Spence
Registration No. 45,699

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

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Sarah B. Simmons

May 20, 2005
Date